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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,394	01/26/2001	Bradley M. Wilkinson	P-3914F1P1P2P1R1	6920

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EXAMINER

THALER, MICHAEL H

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 07/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/771,394

Applicant(s)
Wilkinson et al.

Examiner
Michael Thaler

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3731



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-77 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Jan 26, 2001 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 6) ☐ Other:

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The disclosure is objected to because of the following informalities: None of the corrections made to the specification in the single line format were submitted to the specification in the double line format. In addition, the specification and drawings are replete with numerous errors. For example, each of reference numerals 334, 344, 346, 348 and 350 depicts two different elements as seen in figures 16 and 23. In col. 10, line 63, the depth "a" is between distal termina 438 and what? Dimension "b" is greater than dimension "a" as seen in figures 35c and 35d. Yet, the specification, in col. 10, line 66 contradicts this. In col. 11, line 18-21, it is not seen how proximal end 414 engages at least one of the bosses 442 since these two elements do not come into contact with one another. The entire specification and drawings must be reviewed and these corrections as well as all other necessary corrections are required to be made.

Certain figures of the drawings are labeled "amended". Any change to the patent drawings must be submitted as a sketch showing proposed changes in red for approval by the examiner as required by 37 CFR 1.173 (b) (3).

The "Status of claims and support for claim changes" requirements enumerated in 37 CFR 1.173 have not been met. Any future response must fulfill these requirements, even for the claim changes already made.

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The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following: The declaration fails to mention the error of an inventor (Anthony J. Kosinski) incorrectly not named in an issued patent (MPEP 1412.04).

Claims 1-77 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175. The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Claims 59, 63 and 75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 59 and 75 are confusing and inaccurate since top cut away portion 440 does not extend between two end portions having a raised upper surface. The downwardly extending projection defined in claim 63 is part of the means for releasably connecting the handle to the cartridge defined in claim 62, resulting in a double recitation of the same element.

Claims 59 and 75 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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There is no basis in the original disclosure for the subject matter in these claims for the reasons set forth in the paragraph above.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 30-38, 43-47, 49 and 50 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Aikins (4,491,132). Aikins discloses a cartridge 40 (Member 40 may be considered a cartridge since it holds blade 30.) that may be mounted on a handle 32, comprising a blade holder 40, blade 30 and shield 10. Alternatively, it would have been obvious that member 40 is a cartridge since it holds blade 30. As to claim 32, the proximal end of blade holder 40 defines a beam 54 with a helical pocket (within helical threads at 55). As to claim 33, Aikins discloses a recess (either 58 or 59) for engagement with a handle 16. As to claim 35, Aikins discloses cantilever latch 22, 26. As to claim 36, Aikins discloses a groove 59. As to claim 37, the distal end of groove 59 is upturned from the floor of the groove to form a stop. As to claim 20, Aikins discloses finger placement surface at 20.

Claims 54, 57-59 and 61-66 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Werner (5,292,329). Werner discloses handle 44 defined by a pair of semicircular sidewalls, groove 52, blade 46, shield 42 and latch 64 having an inward projection 66 disposed in groove 52. Alternatively, it would have been obvious that member 44 is a handle since it may be grasped by the hand. As to claim 58, Werner discloses top cut away portion (at 54). As to claim 62, Werner discloses handle 44 comprising proximal hand gripping

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portion (the proximal portion of member 44), intermediate shank 98, tang (one of the two diametrically opposed arc shaped portions extending from the distal end of shank 98) and means 102 for releasably connecting the handle 44 to a cartridge 88 (col. 5, lines 67-68). Alternatively, it would have been obvious that member 44 is a handle since it may be grasped by the hand. As to claim 63, Werner discloses downwardly extending projection 66. As to claims 64 and 65, Werner discloses groove 52 with upturned portion 54. As to claim 66, the Werner tang defines a recess disposed therein (within the arc shape of the tang).

Claims 55, 56 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Werner (5,292,329). As to claim 55, Werner fails to disclose an upturned distal end at the distal end of the groove 52 and the latch 64 being cantilevered. However, it is well known in this art to provide a locks for a surgical scalpel shield so that it may be positively locked both in the retracted and the forward positions. It would have been obvious to provide an upturned end (similar to 54) at the distal end of the groove 52 of Werner so that it too would have this advantage. As to claim 60, Werner fails to disclose an inwardly projecting rail. However, it is well known in this art to provide an inwardly projecting rail on a scalpel shield so that it slides smoothly on the handle. It would have been obvious to provide an inwardly projecting rail on the Werner device so that it too would have this advantage.

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Claims 1-29, 39-42, 48, 51-53 and 67-77 are free of any rejection based upon the prior art of record.


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703)308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3590 for regular communications and (703)305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

mht
June 30, 2003



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731